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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,605	09/27/2001	Edgar Pau	3251/FBR	4654

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EXAMINER

MOSSER, ROBERT E

ART UNIT PAPER NUMBER

3714

DATE MAILED: 11/06/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary

Application No.

09/965,605

Applicant(s)

PAU ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

In response to the amendment filed September 12, 2003 claims 1 through 18 are pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-9, 12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573).

Regarding claim 1, O'Halloran teaches a gaming machine with display means (Element 20) and control means (Element 32) being disposed to play an underlying game with underlying prizes associated with the underlying game (See Figure 2) wherein on the occurrence of a predefined event or triggering event (See Col 1:49) the player is enters a second game in which a common game type with two or more game choices is provided (See Col 1:50-51 & Col 2:12-24). O'halloran further discloses the second game in which the player selects a card from a row of cards and where further the chance of the player selecting a card that would yield a winning out come is inversely proportional to the number of card per the row selected thus indicating a random assignment of the winning card as so claimed (See Col 2:16-24 & Figures 4 and 5), but is silent on including bonus game prizes that are independent of the prize awarded in the

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underlying game and the displaying of at least two winning outcomes within at least one of the prize sets.

Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size of multiple winning outcomes and a non-winning outcome that further spin randomly before stopping on a segment so as to define a prize won, which is independent of any prize awarded in the underlying game and upon defining the prize won the several other possible prize outcomes are displayed to the user (See Figures 4 & 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to included prizes that are independent of the prize awarded in the underlying game of O'Halloran and the displaying at least two winning outcomes within at least one of the prize sets thereof, in light of the teachings of Baerlocher et al, in order to avoid player perception of being penalized for getting a bonus event on a small win in the underlying game or alternatively give the player the perception of a greater amount of total prize possibilities in a similar fashion to the spinning of the reels of a traditional slot machine.

Regarding Claims 2-4 and in addition to the above stated. O'Halloran teaches one winning outcome or the Joker card being presented per row or prize set and at least one non-winning outcome being presented per row or prize set (See Figure 5). This corresponds to one or more prize outcomes, which are identical in the same prize set or in a different prize set (See the middle and

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bottom rows of cards in figure 5) where in the identical prize outcomes are the non-winning outcomes represented via the non-Joker type playing cards.

Regarding Claims 5 and 17 and in addition to the above stated.

Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size and spin randomly before stopping on a segment that defines a prize won (See Figures 4 & 6).

Regarding claims 6-8 and in addition to the above stated. O'Halloran teaches the use of a combination of symbols appearing on the win lines of a spinning reel game of chance for the purposes of triggering a game feature (See Col 3:15-21). This corresponds to the occurrence of a special combination in claim 6 as presented, the triggering of a game feature (triggering event as so claimed) at random in claim 7 as presented where in the random triggering is due to the random alignment of the trigger event or winning combination on a reel game, and a spinning reel game as presented in claim 8 (See Figure 2).

Regarding claim 12 and in addition to the above stated. O'Halloran teaches the presentation of each prize set distinctly as each prize set as so claimed is presented herein as a row of cards (See Figures 4 and 5).

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Regarding claims 9, and 14-16 and in addition to the above stated.

O'Halloran teaches the presentation of player selectable prize sets that includes: winning and non-winning outcomes and identical prize outcomes located between sets and located within the same prize set but is silent on the use of use of segments on a spinning wheel to define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that spin randomly before stopping on a segment that defines a prize outcome won by the player (See Figure 6).

3. Claims 10, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573) in further view of DeMar et al (US Pat 6,315,660).

The combination as taught by O'Halloran/Baerlocher et al taught above is silent regarding the use of dice as the three dimensional object and the use of a board game representations as so claimed. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates a board game feature (Element 62) wherein a random roll of dice (Element 64) or simulation thereof (Element 43) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8,13,16B, and 24). Further as presented in at least claim 11 the prizes defining the faces of the dice corresponds to the number shown on the dice of DeMar and corresponding prize associated with the resultant board position of the player piece/game token combined with the

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display of the prize values that define segments of a wheel as presented in Baerlocher et al and shown above.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of dice as the three dimensional object in game representation in the game as taught by O'Halloran/Baechlocher, in light of the teachings of DeMar et al, in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

Response to Arguments

4. Applicant's arguments with respect to claims 1-18 have been considered but are not deemed persuasive. It is noted that the applicant's arguments attack the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is also noted that applicants representative sets forth, in detail, what each of the three references applied against the claims teaches while also stating that the "cited art fails to teach or suggest.." the invention as claimed. Applicant's representative has failed to set forth, with any degree of specificity, which limitations are not taught or suggested by the prior art when considered as

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applied. The examiner maintains that the combination of references teaches the invention as claimed for the specific reasons set forth above.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

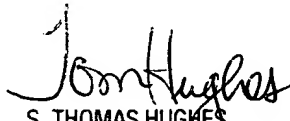
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM


S. THOMAS HUGHES
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